I ATENT

Appl. No. 10/089,525 Amdr. dated November 24, 2004 Reply to Office Action of October 28, 2004

REMARKS/ARGUMENTS

In response to the restriction requirement mailed October 28, 2004, appli ants elect with traverse the claims of Group II (claims 1-12).

The present application is a national phase application of an international application and is subject to the requirement for unity of invention under PCT Rule 13.! Applicants note that an International Search Report addressing all of the pending claims was issued by the International Search Authority. In addition, an International Preliminary Examination Report was issued for this application. The international search and exam nation was carried out by the USPTO. Applicants note that PCT Rule 13.1 governs the unity of invention analysis in both the international application and the national phase. Applicants respectfully request clarification as to how the USPTO can search and examine all the claims of the international application, but not do so in the national phase of the same application when applying the same rule.

Applicants particularly traverse the restriction between Groups I and II. In the Office Action, the Examiner states that the special technical feature of the present invention is "a method of modulating levels of vWF or FVIII in an animal comprising administering a pagent that modulates ST3Gal-IV sialyltransferase activity."

According to PCT Rule 13.2, special technical features are those technical features that define a contribution which each of the inventions, considered as a whole makes over the prior art. Since the Examiner explicitly states that a contribution of the present invention is the *modulation* of ST3 Gal -IV activity, there is no basis for separate examination of claims directed to increasing and decreasing such activity. Thus the restriction between Groups I and II is improper. Indeed, applicants note that there is no discussion in the office action as to why these two groups do not share the special technical feature. In light of the above, the restriction between Group I and II is improper and should be withdrawn.

BEST AVAILABLE COPY

ATENT

Appl. No. 10/089,525 Amdt. dated November 24, 2004 Reply to Office Action of October 28, 2004

If a telephone conference would expedite prosecution of this application the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,

Reg. No. 34,774

TOWNSEND and TOWNSEND and CREW LLP Two Embarcadero Center, Eighth Floor San Francisco, California 94111-3834 Tel: 415-576-0200

Fax: 415-576-0300 Attachments KLB:klb 60363719 v1

This Page is Inserted by IFW Indexing and Scanning Operations and is not part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

□ BLACK BORDERS
☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
☐ FADED TEXT OR DRAWING
☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
SKEWED/SLANTED IMAGES
☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
GRAY SCALE DOCUMENTS
☐ LINES OR MARKS ON ORIGINAL DOCUMENT
☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.